



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/659,262	09/11/2003	Takahiro Moro	00862.001703.2	3540

5514 7590 06/30/2005

FITZPATRICK CELLA HARPER & SCINTO
30 ROCKEFELLER PLAZA
NEW YORK, NY 10112

EXAMINER

POON, KING Y

ART UNIT PAPER NUMBER

2624

DATE MAILED: 06/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/659,262

Applicant(s)

MORO ET AL.

Examiner

King Y. Poon

Art Unit

2624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 March 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 59,61-66,68-72 and 74-80 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 59,61-66,68-72 and 74-80 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☐ Certified copies of the priority documents have been received.
 - 2) ☒ Certified copies of the priority documents have been received in Application No. 08/768,579.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The new title filed on 3/14/2005 has been accepted.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 78, 79, 80 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Regarding claims 78, 79, 80: The limitations "wherein, if change instruction by the user is required, the changing unit changes the set value of the second setting item without the change instruction, otherwise the changing unit changes the set value of the second setting item in response to the change instruction" is subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 59, 61-66, 68-72, 74-77 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hashimoto et al (US 5,006,895).

Regarding claims 59, 66: Hashimoto teaches an information processing apparatus (host computer with a input matrix, decoder and a display, column 7, lines 20-30) connected (fig. 5) with a printing device, (column 7, lines 30-45) comprising: a display unit (e.g., fig. 3) adapted to display a setting window including a set value (e.g., selecting a book size/scanning size, column 9, lines 1-10) of a first setting item (book size/scanning size) for printing (the scan size determines what is being printed) and a set value of a second setting item (selected size of paper, column 6, lines 18-24) for printing; and a changing unit (the program of fig. 7, 8A, and 8B) adapted to, when the set value of the first setting item displayed in the setting window is changed into a second value from a first value (e.g., from a B5 to a A5, column 9, lines 1-15, also see fig. 8A and fig. 8B repeat itself), change the set value (S29, fig. 8B) of the second setting item displayed in the setting window into a fourth value from a third value (from fig. 8A and 8B, if the book size changes and the magnification stays the same, most suitable paper size changes) without a change instruction made by a user (fig. 8A and

Art Unit: 2624

fig. 8B are programs/routine of the host computer, column 8, lines 45-46) if determined to be desirable (most suitable, fig. 8B) to change (also see changed, column 11, line 39) the third value of the second setting item in accordance with the second value of the first setting item, for printing, and adapted to, when the set value of the first setting item displayed in the setting window is changed into a second value from a first value (e.g., from a B5 to a A5, column 9, lines 1-15, also see fig. 8A and fig. 8B repeat itself), change the set value (S31, fig. 8B) of the second setting item displayed in the setting window into a fourth value from a third value (if the paper selected is at the third value as discussed above, the user can select the fourth value, S31) in response to a change instruction made by the user if determined to be desirable (by the user) to change the third value of the second setting item.

Hashimoto does not teach user change the third value of the second setting item in accordance with the second value of the first setting item.

However, as previously discussed, the step S29 is telling the most suitable size paper size to the user in copying the original size (in accordance with the second value of the first setting item) if the paper is not being set in the paper cassette; it would have been obvious to a person (user) with ordinary skill in the art at the time the invention was made to set the paper size in accordance with the second value of the first setting item (the original size) after replacing the correct size of paper in the cassette after the user printing other copy job using the paper in the cassette before the paper is being replaced using AMS mode.

Regarding claims 61, 68: Hashimoto teaches wherein the changing unit displays an operation window (fig. 3) for the change instruction made by the user and changes (S31) the second setting item display in the setting window into the fourth value from the third value if determined that the user makes the change instruction to change the value of the second setting.

Regarding claims 62, 69: Hashimoto teaches wherein the changing unit does not change the third value of the second setting item for printing display in the setting window if not determined that the user makes the change instruction (the setting would not be changed is user does not use S31, fig. 8B, in AMS mode) to change the value of the second setting item.

Regarding claims 63: Hashimoto teaches the information processing apparatus comprising a host computer (column 7, line 24).

Regarding claims 64, 70: Hashimoto teaches wherein the first setting item and the second setting item include a setting of the printing device (column 7, lines 30-45).

Regarding claims 65, 71: Hashimoto teaches wherein the first setting item includes a setting for a medium (scanning medium, original, column 9, lines 1-10) and the second setting item includes a setting for a printing method (using a particular paper for printing, S29, fig. 8B).

Regarding claims 72, 74, 75, 76, 77: Claim 72, 74, 75, 76, 77 are claiming a computer readable medium for storing a program code for the system and method discussed in claims 59, 61, 62, 64, 65. Hashimoto teaches the invention of claims 59, 64, 65, 66, 70, 71 are written in a program (column 10, line 58; also see routine of

column 8, lines 45-46). Inherently, all program codes are stored in a computer readable memory.

Response to Arguments

6. Applicant's arguments, with respect to 112 second paragraph rejection, presented on page 11, and the top of page 12, regarding amended claims 59, 66, and 72, amendment filed on 3/14/2005 have been considered and are persuasive. Therefore, The 112 second rejection is being withdrawn regarding the amended claims.

With respect to applicant's argument that Hashimoto does not teach: when the set value of the first setting item displayed in the setting window is changed into a second value from a first value change the set value of the second setting item displayed in the setting window into a fourth value from a third is response to a change instruction made by the user if determined to be desirable to change the third value of the second setting item; has been considered.

In reply: Hashimoto teaches, adapted to, when the set value of the first setting item displayed in the setting window is changed into a second value from a first value (e.g., from a B5 to a A5, column 9, lines 1-15, also see fig. 8A and fig. 8B repeat itself), change the set value (S31, fig. 8B) of the second setting item displayed in the setting window into a fourth value from a third value (if the paper selected is at the third value as discussed above, the user can select the fourth value, S31) is response to a change instruction made by the user if determined to be desirable (by the user) to change the third value of the second setting item.

Hashimoto does not teach user change the third value of the second setting item in accordance with the second value of the first setting item.

However, as previously discussed, the step S29 is telling the most suitable size paper size to the user in copying the original size (in accordance with the second value of the first setting item) if the paper is not being set in the paper cassette; it would have been obvious to a person (user) with ordinary skill in the art at the time the invention was made to set the paper size in accordance with the second value of the first setting item (the original size) after replacing the correct size of paper in the cassette after the user printing other copy job using the paper in the cassette before the paper is being replaced using AMS mode.

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

Art Unit: 2624

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

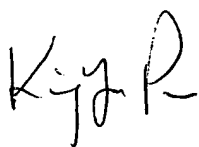
Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to King Y. Poon whose telephone number is 571-272-7440. The examiner can normally be reached on Mon-Fri 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Moore can be reached on 571-272-7437. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

June 27, 2005



**KING Y. POON
PRIMARY EXAMINER**